



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,926	02/22/2002	Lin Zhi	015110.0096.UTL1	7786

7590

01/13/2003

Richard H. Pagliery
Brobeck, Phleger & Harrison LLP
12390 El Camino Real
San Diego, CA 92130-2081

EXAMINER

HUANG, EVELYN MEI

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080,926

Applicant(s)

ZHI ET AL.

Examiner

Evelyn Huang

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-97 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-27, 30-63 in part, drawn to a compound wherein $X=O$, $n=0$, classified in class 549, subclass 387, and the composition thereof.
 - II. Claims 1-26, 30-37, 40-55, 57-61 in part, drawn to a compound wherein $X=S$, $n=0$, classified in class 549, subclass 43, and the composition thereof.
 - III. Claims 1-63 in part, drawn to a compound wherein $X=NR^{14}$, $n=0$, classified in class 546, subclass 85 and the composition thereof.
 - IV. Claims 1-21, 23-53, 55-63 in part, drawn to a compound wherein $X=O$, $n=1$, classified in class 549, subclass 388, and the composition thereof.
 - V. Claims 1-21, 23-26, 30-38, 40-53, 55, 57-61 in part, drawn to a compound wherein $X=S$, $n=1$, classified in class 549, subclass 26, and the composition thereof.
 - VI. Claims 1-21, 23-53, 55-63 in part, drawn to a compound wherein $X=NR^{14}$, $n=1$, classified in class 546, subclass 88, and the composition thereof.
 - VII. Claims 1-20, 23-38, 40-53, 55-62 in part, drawn to a compound wherein $X=O$, $n=2$, classified in class 549, subclass 354, and the composition thereof.

Art Unit: 1625

- VIII. Claims 1-20, 23-26, 30-38, 40-53, 55, 57-62 in part, drawn to a compound wherein $X=S$, $n=2$, classified in class 549, subclass 12, and the composition thereof.
- IX. Claims 1-20, 23-38, 40-53, 55-62 in part, drawn to a compound wherein $X=NR^{14}$, $n=2$, classified in class 540, subclass 580, and the composition thereof.
- X. Claims 64-94, drawn to a method of treating an individual having a condition mediated by an androgen receptor. If this group is elected, further restriction according to the above groups I to IX would be required.
- XI. Claim 95, drawn to a method of treating cancer. If this group is elected, further restriction according to the above groups I to IX would be required.
- XII. Claim 96, drawn to a method of determining the presence of an androgen receptor in a cell or cell extract. If this group is elected, further restriction according to the above groups I to IX would be required.
- XIII. Claim 97, drawn to a method for purifying a sample containing an androgen receptor in vitro. If this group is elected, further restriction according to the above groups I to IX would be required.

The inventions are distinct, each from the other because of the following reasons:

The compounds of Groups I to IX are structurally and patentably distinct as they have acquired a separate status in the art as shown by their different classification. A reference anticipating the group I invention would not rendered obvious the compounds of the other groups. The search is not co-extensive and is therefore burdensome.

Inventions I-IX and X-XIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the

Art Unit: 1625

product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the inventive compound can be used in a materially different processes as evidenced in the different independent method claims, such as in the treatment of an individual suffering from a condition mediated by the androgen receptor, or alternatively, in the treatment of cancer in a patient, and it can be used in the determination of the presence of the androgen receptor in a cell or cell extract, or in the purification of a sample containing an androgen receptor.

Because these inventions are distinct for the reasons given above and the search required for one group is not required for the other groups, restriction for examination purposes as indicated is proper.

2. A telephone call was made to Mr. Pagliery on 12-19-2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must ***include an election of the invention and a species within the elected invention*** to be examined even though the requirement be traversed (37 CFR 1.143).

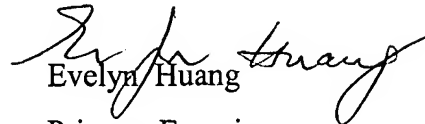
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 703-305-7247. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Art Unit: 1625

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Evelyn Huang

Primary Examiner

Art Unit 1625

December 19, 2002